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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,398	03/07/2001	Peter O. Schmidt	HELLO-08600	4052

28960 7590 08/07/2002
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EXAMINER

BRITTAIN, JAMES R

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

09/801,398

Examiner

James R. Brittain

Applicant(s)

SCHMIDT ET AL.

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☒ Other: *Not. irr. mail*

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 6, 8, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 4754528) in view of McKnight (US 4580347).

Lyons et al. (figures 1, 2) teach a clip 25 for securing an object, in particular a tape measure 13, which when not in use is carried on the belt or clothing worn by a person (col. 1, lines 4-14), the object 13 having a first surface 17 and a second surface 20, wherein the first surface 17 is adapted to be worn adjacent to the person and the second surface 20 positioned substantially perpendicular to the first surface 17, the clip comprising: a first segment and a second segment 19, the first segment positioned substantially adjacent to the first surface terminating in a projection 18 at its distal end catching the belt 15 between the clip and object, and the second segment 19 positioned substantially adjacent to the second surface 19, the clip is resiliently coupled by the spring 26 with the object such that pressing the second segment 19 toward the second surface 20 rotates the first segment away from the first surface. The locking apparatus is formed from a single strip of rigid metal to form a flat plate 25, whose bottom edge is bent at a substantially right angle to form a lip 18 to abut the lateral surface 17 of the object and whose top end is bent also at a substantially right angle to form an angled

Art Unit: 3677

portion 19 passing over the top surface of the object (col. 3, lines 16-27). Lyons et al. explain the operation of their device (col. 3, lines 50 - col. 4, line 2):

lated. To open the enclosure formed by the plate 25, 50
spring clip 26, lip 18 and lateral face 17, the user presses
down on the angled top 19 of the belt lock, thereby
narrowing and closing the gap 29. This pivots the plate
25 so that its bottom portion moves away from the
lateral face 17 of the housing, separating the lip 18 from 55
the lateral face to provide an opening for slipping the
locking apparatus over the belt (or removing it from the
belt). The locking apparatus in this open position is
shown in dashed lines. Return of the locking apparatus
to its locking position with full encirclement of the belt 60
is achieved by merely releasing the pressure on the
flange 19 the spring action of the spring clip 26 urging
the plate 25 back into the position shown in solid lines
with the lip 18 abutting the lateral face 17 of the hous- 65
ing. This is a one hand operation which the user per-
forms by placing the heel of his hand on the angled top
19, with the palm of his hand and fingers extending
down the opposite lateral face 30 of the housing and the

fingers curling underneath the housing to grip its under-
surface 31.

The difference is that the clip is resiliently biased by the spring 26 and not rotatably coupled with the object. However, McKnight (figures 1, 2) teaches a clip 48 for securing an apparatus 20, in particular a tape measure, which when not in use is carried on the belt or waistline worn by a person so as to be secured between the flexing arm member and body of the apparatus (col. 2, lines 33-38), the apparatus 20 having a permanently adhered portion 45 secured to a first surface 12 and a top second surface, wherein the permanently adhered portion 45 is adapted to be worn adjacent to the person and the top second surface is positioned substantially perpendicular to the first surface 12, the clip comprising: a first segment and a second segment 54, the first segment positioned substantially adjacent to the first surface 12 and having teeth

Art Unit: 3677

thereon for engaging for engaging the article worn by a person, and the second segment 54 positioned substantially adjacent to the top second surface, the clip 48 is coupled by the spring loaded hinge member 46 with the object such that pressing the second segment 54 toward the top second surface rotates the first segment away from the first surface. The spring loaded hinge member 46 is located at a position proximal to the second segment 54. McKnight explains the operation of his device (col. 3, lines 45-68):

When the apparatus is not in use, there is provided on 45 wall portion 12, an attachment means 44, which comprises a base plate 45 permanently adhering to wall 12, being substantially flat and unobtrusive. On the upper end portion of base plate 45 there is provided hinging means 46, which hingedly engages a flexing arm member 48, which is substantially the same configuration or shape as base plate 45, and which flexes onto and away from base plate 45 as seen by arrow 49. Arm member 48, is normally in the closed position as seen in FIG. 1, due to a spring loaded hinge member 46, so that the spring 55 would actuate arm member 48 in engagement against base plate 45. As seen in FIG. 1, arm member 45 further comprises a plurality of teeth 52, which would normally engage the belt or exterior of the waistband of trousers when the waistband is placed between base plate 45 and 60 flexing arm member 48. In the placement thereof, there is provided an upper plate member 54, which when pressure is put thereupon, and it is pressed downward, the arm member 48 moves outwardly away from base plate 45 against the biasing of the spring. This would 65 insure easy placement and removal of the apparatus from the belt or waistband should one want to utilize the apparatus.

The construction including the use of a spring loaded hinge member aids in insuring easy placement and removal of the apparatus from the belt or waistband.

It would have been obvious to modify the clip of Lyons et al. so that the clip is rotatably coupled with the object in view of McKnight teaching the desirability of using a

Art Unit: 3677

spring loaded hinge member 46 to bias the clip 48 to aid in insuring the easy placement and removal of the apparatus from the belt or waistband. In regard to claims 16 and 17 it would have been obvious to position the rotatable coupling at a position proximal to the second segment in view of McKnight teaching such structure so as to insure easy placement and removal of the apparatus from the belt or waistband.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyones et al. (US 4754528) in view of McKnight (US 4580347) as applied to claims 1, 2, 5, 6, 8, 16 and 17 above, and further in view of JP 11-40952.

Further modification of the device of Lyons et al. so that it is used on an electronic device would have been obvious in view of JP 11-40952 (figures 1, 2) providing evidence of the desirability to secure a clip 2 to an electronic device 1 so as to mount it to the waist. The problem recognized by Lyons et al. and McKnight exists for all users of belt clips and it would have obvious to modify the teachings of Lyons et al. so that it is used with electronic devices since JP 11-40952 teaches that belt clips are used on electronic devices, too. Further, as to claim 11, JP 11-40952 teaches that it is advantageous to provide an elastic adapter with a high coefficient of friction so that the belt is not damaged. Applicant doesn't indicate in the claim that the adapter is removable and the device of JP 11-40952 is considered an adapter and its use with the device of Lyons et al. would have been obvious so as to prevent damage to a belt.

Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabenecker (UK 2339834) in view of Zuckerman et al. (US 5890,634).

Rabenecker (figure 1) teaches an adapter in the form of a nub bar made of silicone rubber inserted into cutouts 13, 14 in the segment 8 of the clip so as to increase the friction on smooth materials and can be removed in order to fasten the object, a mobile measuring instrument 7, to thicker materials or belts (page 4, lines 10-14), wherein the clip is coupled to an object and having a segment 8 which secures the object to an article worn by a person, the object having a surface formed as part of the housing 6 adapted to be worn adjacent to the person, the adapter coupled to the segment by insertion into cutouts 13, 14 in the clip and positioned between the segment and the surface of the object, wherein the adapter inherently has an adapter length. The clip segment 8 has a protrusion 15 on the distal end, the protrusion facing toward the surface and having a predetermined length such that the protrusion catches the article between the clip and the object.

The difference is that the adapter bar is nubbed and not flat. However, Zuckerman et al. (figures 1-3, 6, 8) teaches flat adapter structure 40 for providing a flat surface to a clip 26, 28, wherein the clip is used to hang clothing, wherein the adapter has an adapter length. Zuckerman et al. teach that it is desirable to have a flat adapter so that the fabric is neither damaged or marked rather than use damaging projections or cleats in the clamp jaws (col. 1, lines 19-63). This is accomplished by a resilient friction material 44 (col. 5, lines 28-37). The adapter is also securable and removable by an easy snap-in/snap-out motion so that differing fabrics can be gripped (col. 2, lines 14-32) that provides important versatility. It can be used to cover a roughened or nipped clamping surface so as to provide more versatility (col. 6, lines 51-64).

It would have been obvious to modify the adapter of Rabenecker so that the adapter bar is flat in view of Zuckerman et al. teaching it is desirable to have a flat adapter 40 with a surface 44 made of resilient friction material for providing a flat surface to a clip rather than a nubbed surface so that the fabric is neither damaged or marked rather than use damaging projections or cleats in the clamp jaws (col. 1, lines 19-63). In regard to claim 14, Rabenecker suggests inserting the adapter bar into cutouts 13, 14 in the segment 8 of the clip and that the adapter bar is removable from the segment 8. It would have been obvious to use the configuration suggested by Zuckerman et al. as providing a protrusion 54 for attaching the adapter to the segment, wherein the adapter attaches to the segment by fitting the protrusion 54 within a slot 52 located in the segment since such structure provides for easy securement and release.

Claims 3, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 4754528) in view of McKnight (US 4580347) as applied to claims 2 and 6 above, and further in view of JP11-40952.

Further modification of the device of Lyons et al. so that it has an adapter coupled with the first segment of the clip, the adapter positioned between the first segment of the clip and the first surface of the object and having an adapter length greater than the predetermined length would have been obvious in view of JP11-40952 (figures 1, 2) teaching that it is advantageous to have an elastic adapter 5 made of a material with a high coefficient of friction coupled with the first segment of the clip, the adapter positioned between the first segment of the clip and the first surface of the object and having an adapter length at the bead 5a greater than the predetermined

Art Unit: 3677

length of the projection at the end of the clip so that the belt is not damaged. Applicant doesn't indicate in the claim that the adapter is removable and the device of JP 11-40952 is considered an adapter.

Response to Arguments

Applicant's arguments filed May 30, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the teachings of Lyons et al. and McKnight comprise McKnight teaching the desirability of using a spring loaded hinge member 46 to bias the clip 48 that contributes in insuring the easy placement and removal of the apparatus from the belt or waistband as McKnight explains the operation of his device (col. 3, lines 45-68).

Applicant asserts that McKnight teaches away from Lyons et al. because of the placement of the spring in Lyon et al. relative to that of McKnight and that this teaches away from Lyons et al. This is not persuasive. McKnight is utilized for the suggestion to use a rotatable coupling of the clip to the object proximal to the second segment. This connection is well known and McKnight does not teach away. As to the remarks


Art Unit: 3677

regarding the use of teeth in the clip of McKnight to grip the belt and that this also teaches away from Lyon et al. This is not persuasive because McKnight suggests a rotatable coupling of the clip to the object proximal to the second segment as contributing to insure the easy placement and removal of the apparatus from the belt or waistband as McKnight explains the operation of his device (col. 3, lines 45-68).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on Monday - Friday from 5:30 to 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



James R. Brittain
Primary Examiner
Art Unit 3677

JRB
August 1, 2002

Application/Control Number 09/801,348
Art Unit 3677

Attachment to Paper No. 7

Notice Regarding Treatment of Irradiated Correspondence

The following papers have not been made part of the permanent records of the United States Patent and Trademark Office (Office) for this application (37 CFR 1.52(a)) because of damage from the United States Postal Service irradiation process:

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The above-identified papers, however, were not so damaged as to preclude the USPTO from making a legible copy of such papers. Therefore, the Office has made a copy of these papers, substituted them for the originals in the file, and stamped that copy:

COPY OF PAPERS ORIGINALLY FILED

If applicant wants to review the accuracy of the Office's copy of such papers, applicant may either inspect the application (37 CFR 1.14(d)) or may request a copy of the Office's records of such papers (*i.e.*, a copy of the copy made by the Office) from the Office of Public Records for the fee specified in 37 CFR 1.19(b)(4). Please do **not** call the Technology Center's Customer Service Center to inquiry about the completeness or accuracy of Office's copy of the above-identified papers, as the Technology Center's Customer Service Center will **not** be able to provide this service.

If applicant does not consider the Office's copy of such papers to be accurate, applicant must provide a copy of the above-identified papers (except for any U.S. or foreign patent documents submitted with the above-identified papers) with a statement that such copy is a complete and accurate copy of the originally submitted documents. If applicant provides such a copy of the above-identified papers and statement within **THREE MONTHS** of the mail date of this Office action, the Office will add the original mailroom date and use the copy provided by applicant as the permanent Office record of the above-identified papers in place of the copy made by the Office. Otherwise, the Office's copy will be used as the permanent Office record of the above-identified papers (*i.e.*, the Office will use the copy of the above-identified papers made by the Office for examination and all other purposes). This three-month period is not extendable.